



AP 3743 IPW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/726,953
Filing Date	November 29, 2000
First Named Inventor	Ricardo Guimaraes
Art Unit	3743
Examiner Name	Fadi H. Dahbour
Attorney Docket Number	155615-0018 (P009)

ENCLOSURES (Check all that apply)

- | | | |
|--|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form
<input type="checkbox"/> Fee Attached
<input type="checkbox"/> Amendment/Reply
<input type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)
<input type="checkbox"/> Extension of Time Request
<input type="checkbox"/> Express Abandonment Request
<input type="checkbox"/> Information Disclosure Statement

<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers

<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
<input type="checkbox"/> Power of Attorney, Revocation
Change of Correspondence Address

<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Request for Refund

<input type="checkbox"/> CD, Number of CD(s) _____
<input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC

<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences

<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)

<input type="checkbox"/> Proprietary Information

<input type="checkbox"/> Status Letter

<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Return Postcard |
|--|---|---|

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Irell & Manella LLP		
Signature			
Printed name	Brian E. Jones		
Date	September 28, 2005	Reg. No.	51,855

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Susan M. Langworthy	Date	September 28, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2005		Complete if Known	
		Application Number	09/726,953
		Filing Date	November 29, 2000
		First Named Inventor	Ricardo Guimaraes
		Examiner Name	Fadi H. Dahbour
		Art Unit	3743
		Attorney Docket No.	155615-0018 (P009)
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27			
TOTAL AMOUNT OF PAYMENT	(\$)	0	

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 09-0946 Deposit Account Name: Irell & Manella LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims - 20 or HP = _____ x _____ = _____ **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20

Indep. Claims - 3 or HP = _____ x _____ = _____ **Fee Paid (\$)**

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	_____ / 50 = _____	_____ (round up to a whole number)	_____ x _____ = _____	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount) _____ **Fees Paid (\$)**

Other: _____

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent) 51,855	Telephone 949-760-0991
Name (Print/Type)	Brian E. Jones	Date September 28, 2005	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Application of:

Ricardo Guimaraes

Application No.: 09/726,953

Filed: November 29, 2000

For: **LASIK LAMINAR FLOW
SYSTEM**

Examiner: Fadi H. Dahbour

Art Group: 3743

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits this Reply Brief in triplicate pursuant to 37 C.F.R. § 1.193(b)(1) for consideration by the Board of Patent Appeals and Interferences. Although Applicant believes that no fee is required, the Office is authorized to charge any necessary filing fee for a small entity to Deposit Account No. 09-0946.

I. INTRODUCTION

Although the Examiner's Answer (the "Answer") raises some new issues, none of them support a rejection of the claims on appeal. For instance, the Answer confirms that U.S. Patent No. 6,019,754 ("Kawesch") does not explicitly teach directing a flow of air above the cornea at a distance such that the cornea is not de-hydrated by the flow of air. Moreover, the Answer and the prior Office Actions failed to show how such a teaching is inherent in Kawesch or that one of ordinary skill in the art would be motivated to make such a change. The only motivation to make a change to Kawesch has come from Applicant's disclosure, which is improper. Accordingly, the rejections of claims 1-14 should be reversed.

II. THE ARGUMENTS RAISED IN THE EXAMINER'S ANSWER DO NOT SUPPORT AFFIRMANCE OF THE REJECTIONS

As discussed in Applicant's opening brief, to show that a claim is invalid because of anticipation or obviousness, a reference or a combination of references must meet every limitation of the claim. See MPEP 2131; MPEP 2143.03. Despite the Answer's comments to the contrary, a review of Kawesch shows that Kawesch discloses the exact opposite of the claimed invention.

A. The Anticipation Rejection Of Claims 12-14 Is Unsupported

In Applicant's Appeal Brief, it was suggested that the claims on appeal stand or fall together. In light of the Examiner's answer, however, it has become apparent that independent claim 12 is allowable along with its dependent claims. More specifically, the argument was raised that Kawesch anticipates because "it 'can' direct or is capable of directing a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not de-hydrated by the flow of air."¹ As

¹ Examiner Answer, Page 5.

the Examiner noted, this argument only applies to claims 1 and 8, and not to claim 12.

Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,"² the rejection of claim 12 cannot stand.

The Examiner's Answer also raises two other issues that do not affect this result. First, the Answer raises an issue with the disclosure in the application. This issue is irrelevant because all of the independent claims at issue contain the following language: "at a distance so that the cornea is not de-hydrated by the flow of air." And, as described on page 7, lines 11-13, the application directly supports this claim language: "it is desirable to create an airflow that does not directly impinge the cornea to prevent corneal de-hydration."

The second issue raised by the Answer -- that Kawesch only teaches drying of the gutter area -- also does not mandate a different result. Figures 1 through 5 of Kawesch illustrate an eye 10, which includes a cornea 12.³ As part of the LASIK procedure, the cornea 12 is sliced from the side to produce a corneal flap 16.⁴ A gutter area 22, which Figure 5 illustrates as being a part of the cornea 12, "defines the edge of the cornea/flap interface."⁵ The Answer leaves no doubt that the gutter area 22 is dried per Kawesch. Logic dictates that if the gutter area 22 were being dried, the rest of the cornea 12 would also be dried due to its proximate location. In line with this reasoning, Kawesch confirms that the corneal flap is dried: "After the corneal flap is repositioned, **a flap drying apparatus** is used to **dry the repositioned corneal flap**" ... "The Kawesch **flap dryer** has been used on a number of patients, all of whom seem to see better upon sitting up following the procedure than those whose **corneal flaps have not been dried** following the procedure."⁶

² MPEP 2131.

³ Kawesch at Col. 2:23-25.

⁴ Kawesch at Col. 2:28-30; Figs. 3-5.

⁵ Kawesch at Col. 5:44-45; Fig. 5.

⁶ Kawesch at Abstract; Col. 5:56-59 (bold added).

In sum, none of the comments made in the Answer change the fact that Kawesch does not disclose, teach, or suggest the claimed method in claims 12-14.

B. The Obviousness Rejection Cannot Stand

The Examiner's Answer also failed to support a *prima facie* case of obviousness for independent claims 1 and 8. To establish a *prima facie* case, the claim element at issue must be taught or suggested by Kawesch.⁷ As discussed above and in Applicant's Appeal Brief, Kawesch does not teach "an air flow module that can direct a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not de-hydrated by the flow of air" as recited in claims 1 and 8. Such a disclosure is not explicit in Kawesch because, although the Answer suggests that the module in Kawesch "can" be used in such a manner, there isn't any express description that the Kawesch flap dryer could be or is in fact used in such a manner. Moreover, such a disclosure is not inherent in Kawesch because the Kawesch flap dryer is not necessarily used so that the cornea is not de-hydrated by the flow of air as recited in the claims at issue.

The Examiner has also failed to show how one of ordinary skill in the art would have been motivated to create the claimed invention based on Kawesch. MPEP 2143.01 explicitly states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." The Examiner has made no showing that Kawesch (or any other reference) suggests the desirability of the claimed combination. Use of Applicant's disclosure is mere hindsight analysis that must be rejected.

Even more, MPEP 2143.01 further states that "if [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Modifying the

⁷ MPEP 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

Kawesch flap dryer such that it would not dry the cornea would render Kawesch unsatisfactory for its intended purpose – convective drying of the corneal flap and gutter area. Likewise, such a modification would change the principle of operation of Kawesch, which is not allowed for a *prima facie* case of obviousness. MPEP 2143.01 ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."). Indeed, because Kawesch's very purpose is drying of the cornea, it teaches away from the very anti-thesis that is claimed – "so that the cornea is not de-hydrated by the flow of air."

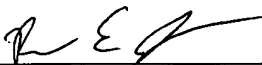
The other arguments raised by the Answer regarding Applicant's disclosure and the gutter area are also without merit for the reasons stated previously. Consequently, the rejection of claims 1-11 should be reversed.

III. CONCLUSION

Kawesch contains no disclosure whatsoever of directing a flow of air in a manner that does not de-hydrate the cornea. In addition, a motivation for doing so has not been provided for a simple reason – this would be contrary to the teachings of Kawesch and would render the Kawesch flap dryer unsuitable for its intended purpose. Consequently, the rejection of independent claims 1, 8 and 12, and their associated dependent claims, should be reversed.

Respectfully submitted,
IRELL & MANELLA LLP

Dated: Sept. 28, 2005

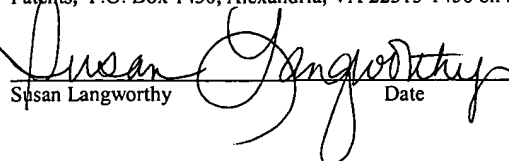


Brian E. Jones, Reg. No. 51,855

840 Newport Center Drive, Suite 400
Newport Beach, CA 92660
949-760-0991

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on Sept. 28, 2005.



Susan Langworthy Date Sept 28, 2005